

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Simon HAKIEL, et al.	:	Confirmation Number: 9639
	:	
Application No.: 10/667,581	:	Group Art Unit: 2143
	:	
Filed: September 22, 2003	:	Examiner: K. Belani
	:	
For: A METHOD OF DISPLAYING EVENTS	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated October 16, 2008.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of July 28, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 4-14 of the Examiner's Answer with the statement of the rejection found on pages 2-13 of the Fourth Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Second Appeal Brief is found on pages 14-18 of the Examiner's Answer.

On page 5, line 1 through page 6, line 9 of the Appeal Brief, Appellants presented arguments as to the Examiner's failure to establish that Wilson discloses the claimed "receiving a filter representing a set of the one or more computer environments," which the Examiner relied upon Wilson to teach. Appellants also addressed the Examiner's initial response to Appellants' prior arguments as to these limitations. The Examiner's response to these arguments are found in the paragraph spanning pages 15 and 16 and in the first full paragraph on page 16 of the Examiner's Answer.

The Examiner's assertions found in the paragraph spanning pages 15 and 16 is in response to Appellants arguments on page 5, line 32 through page 6, line 2 of the Appeal Brief. Specifically, Appellants noted that the Examiner asserted that Wilson teaches "a user selects a specific plug-in module." However, the passage cited by the Examiner only states that certain functionality permits "the detection code to *act as* plug-in modules" (emphasis added). Thus,

Appellants argued that Wilson does not appear to teach what the Examiner is asserting that Wilson teaches. These arguments (and the Examiner's response thereto), however, are only a side issue that are not particularly germane to Appellants' main arguments.

The Examiner's response to Appellants' main arguments (see page 5, lines 1-16 and page 6, lines 4-9 of the Appeal Brief) is found in the first full paragraph on page 16 of the Examiner's Answer, which is reproduced below:

The appellants' assertion that the teaching in the Wilson et al. reference that event data being filtered comes from different computer environments is not comparable to a teaching that the filter itself represents a set of one or more computer environments, lacks credibility, because a filter itself does not represent computer environments, it is some computer code that selects a user specified portion of data (or events) from a larger set of relevant data. No reason is provided as to why the teaching of Wilson et al. is not comparable to the teaching of claim 1. Event Monitoring elements 70-76 shown in Fig. 3 include filter code to select either system events (element 70), or network events (element 72) or database events (elements 74 and 76), which are three different computer environments. (underline of first passage in original; underline of second passage added)

The Examiner's assertion that "a filter itself does not represent computer environments" stands in stark contrast to the claim language at issue of "a filter representing a set of the one or more computer environments." Since the Examiner believes that "a filter itself does not represent computer environments," the Examiner could not have found a teaching "a filter representing a set of the one or more computer environments" with Wilson. Otherwise, the Examiner would not have made such an assertion.

The Examiner's assertion that "[n]o reason is provided as to why the teaching of Wilson et al. is not comparable to the teaching of claim" reflects a fundamental misunderstanding as to the burden placed on the Examiner during examination. Appellants recognize that an *ipse dixit* test, i.e., identity of terminology is not required to establish that the applied prior art teaches a particular limitation. However, the burden still rests with the Examiner to explain why

"feature X" disclosed by the prior art allegedly teaches the claimed "feature Y." "Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art." Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted). Therefore, the Examiner can properly discharge the burden of showing that "feature X" teaches the claimed "feature Y" by providing a claim construction for feature Y that establishes that one having ordinary skill in art would recognize feature X, within the prior art, as being the same as claimed feature Y. The Examiner, however, has failed to provide a claim construction for the claim limitations at issue.

Notwithstanding the Examiner's failure to provide an explanation for the Examiner's assertions, the Examiner is trying to associate the claimed "computer environment" with events (i.e., systems events, network events or database events). An "event" is not the same as an "environment." An computer environment is the circumstances, objects, or conditions that surround a computer. In contrast, a system/network/database event is something that happens and is associated with either the system/network/database. By analogy, stormy weather is an environment, whereas a lightning strike is an event. Similarly, "System 1" is an example of a computer environment (see paragraph [0036] of Appellants' disclosure), whereas a general protection fault (see page 6, lines 34-35 of Wilson) is an example of an event.

Therefore, for the reasons stated above and in the Appeal Brief, Appellants maintain that the Examiner has erred in characterizing the scope and content of Wilson.

On page 6, line 12 through page 8, line 24 of the Appeal Brief, Appellants presented arguments as to the Examiner's failure to properly characterize the scope and content of Ditmer. The Examiner's response to these arguments is found in the first full paragraph on page 17 of the Examiner's Answer and reproduced below:

The examiner begs to differ. The display on a single workstation is quite capable of displaying a single window, as happens in the display of a desktop, or any other fully expanded window. Furthermore, the Ditmer reference was relied upon to only disclose the claim element specifying "a single display window". The filter and the data for the computer environments it processes are already disclosed by the Wilson et al. reference, even though the Ditmer et al. reference also discloses filtering event data such as alarms, which certainly occur in different computer environments. In response to appellants' arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combination of references. In any case, the examiner relied upon the Ditmer et al. reference to only disclose the claim element specifying "a single display window". As to the appellants' argument that the Wilson and Ditmer references have different applications, and therefore should not have been combined, the examiner does not agree with such assertion. Filtering alarms in a voice and data network of MCI/WorldCom, as disclosed in the Ditmer et al. reference is in the same application class as any other event monitoring method in a computer environment.

The Examiner's assertion that "[t]he display on a single workstation is quite capable of displaying a single window" is an unstated inherency argument. Essentially, the Examiner is asserting that since the single workstation is "quite capable of" displaying a single window, then the single workstation teaches the claimed "a single display window," which is found in the claimed "the filter is received from, and the one or more filtered events are displayed on, a single display window."

Appellants respectfully submit that the Examiner's reliance upon the doctrine of inherency to disclose the claim limitation at issue is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a

given set of circumstances is not sufficient to establish inherency.¹ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.² This burden has not been met. As also held by the Honorable Board of Patent of Appeals and Interferences in the case of In re Schriker,³ "[i]nherency and obviousness are somewhat like oil and water-- they do not mix well."

The Examiner asserted that "the examiner relied upon the Dittmer et al. reference to only disclose the claim element specifying 'a single display window.'" Based upon this admission by the Examiner, a legal conclusion of obviousness as to claim 1 based upon the applied prior art cannot stand. Claim 1 does not simply recite "a single display window," in isolation. Instead, claim 1 recites that the filter is received from, and the one or more filtered events are displayed on, a single display window. By ignoring that the claimed "single display window" is also associated with other claim limitations, the Examiner has failed to consider the claimed invention, as a whole.

The Examiner's assertions regarding "attacking references individually" is frequently used boilerplate language found in many responses to arguments as to obviousness rejections. Moreover, this boilerplate language is frequently misused. In the statement of the rejection, the Examiner has relied upon both Wilson, Dittmer, and Black, individually, to teach certain of the

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

³ 56 USPQ2d 1723, 1725 (BPAI 2000).

1 claimed limitations. Thus, upon the Examiner relying only on Ditmer to teach or suggest
2 particular limitations, Appellant's position is that an *appropriate* argument is to establish that
3 Ditmer does not teach the particular limitations for which only Ditmer is being relied upon to
4 teach. This line of reasoning should also hold true for a situation in which the Examiner relies
5 only upon another reference (e.g., Wilson or Black) to teach or suggest particular claimed
6 limitations. Put differently, when the Examiner makes a factual findings as to the scope and
7 content of the prior art, which is one of the required *Graham* findings of fact, Appellants can
8 argue that the Examiner has mischaracterized the scope and content of the prior art. Thus, the
9 Examiner's arguments are misplaced.

10
11 The Examiner's assertion that "Ditmer et al. reference is in the same application class as
12 any other event monitoring method in a computer environment" is not legally relevant. Whether
13 or not Ditmer is within the "the same application class as any other event monitoring method in a
14 computer environment" is immaterial to the arguments presented by Appellants on page 8, lines
15 10-17 of the Appeal Brief, which were directed to the Examiner's failure to making a finding as
16 to as reasonable expectation of success. Referring to the "Examination Guidelines for
17 Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR
18 International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination
19 Guidelines), the Examiner appears to be using rationale (G). As such, referring to page 57,534 of
20 the Examination Guidelines, one of the findings of fact that must be articulated by the Examiner is
21 "a finding that there was reasonable expectation of success." This burden, however, has not been
22 met by the Examiner since the finding that "Ditmer et al. reference is in the same application

class as any other event monitoring method in a computer environment" does not establish a reasonable expectation of success.

On page 8, line 2 through page 11, line 14 of the Appeal Brief, Appellants presented arguments as to the Examiner's failure to properly characterize the scope and content of Ditmer and the Examiner's failure to establish a rationale that would have rendered the claimed invention obvious in view of the applied prior art. The Examiner's response to these arguments is found in the paragraph on spanning pages 17 and 18 of the Examiner's Answer and reproduced below:

On page 9 of the appeal brief, the appellants mischaracterize the inclusion of a full claim element instead of a phrase "a single display window", to state that the examiner's assertion that "the examiner needed the combination with Ditmer et al. only to show 'a single display window' feature of claim" stands in stark contrast to the examiner's assertion in the paragraph spanning pages 4 and 5 of the Second Office Action, fully realizing that the remaining features in the included claim element have already been disclosed in the Wilson et al. reference. This was clearly stated in the "Response to Arguments" section of the final office action after RCE, wherein the examiner's response was "The applicants also argue that Ditmer et al. reference does not teach filtering events (which are associated with one or more computer environments) based upon a filter representing a set of the one or more environments as claimed. As explained above, this element of claim 1 is taught by Wilson et al. reference. Yet, the Ditmer et al. reference also discloses the filtering of events based on alarms, which are raised when certain events cross the specified thresholds". Therefore, the examiner respectfully disagrees with appellants above argument, which requires no further response.

The Examiner again admits that Ditmer is only being used to teach "a single display window." Notwithstanding that Ditmer fails to teach this particular limitation (as discussed above), the Examiner's analysis confirms that Wilson is being used to teach the other limitations. However, (as also discussed above), by ignoring that the claimed "single display window" is also associated with other claim limitations, the Examiner has failed to consider the claimed invention, as a whole.

Appellants also note that the Examiner has essentially ignored the arguments presented on page 8, line 27 through page 9, line 15 of the Appeal Brief. As also noted on page 10, lines 10-14, the Examiner also ignored these arguments in the Fourth Office Action. To rephrase these arguments, the critical question to be answered in determining whether a certain combination of references renders a claim obvious does not revolve around whether there is *some* motivation to combine the references. The Federal Circuit has recognized that "virtually all [inventions] are combinations of old elements," In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)), and Appellants do not doubt that some motivation/common sense rationale to combine references in analogous or even non-analogous prior art can almost always be found. However, evidence of a motivation/common sense rationale to combine references does not automatically equate to a claimed invention being obvious based upon the applied combination, even if all of the claimed limitations are found in the applied prior art.

Instead, the critical question to be answered lies in determining whether one having ordinary skill in the art would consider the claimed invention to be obvious in view of the applied prior art. Therefore, if the alleged motivation/common sense rationale leads to a combination that does not result in the claimed invention, then the claimed invention would not be obvious in view of the applied prior art. Furthermore, if the secondary reference already addresses a problem has already been solved, one having ordinary skill in the art would not have been realistically impelled to make the Examiner's proposed modification. See Ex parte Rinkevich, Appeal 2007-1317 (non-precedential) ("we conclude that a person of ordinary skill in

the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

As argued in the Appeal Brief, the Examiner's asserted rationale for the combination (i.e., "to provide the users with specific events based on filter defined by the users") does not necessarily result from the proposed combination. Specifically, the Examiner's asserted rationale (i.e., "to provide the users with specific events based on filter defined by the users") can be accomplished regardless of whether or not "the filter is received from, and the one or more filtered events are displayed on, a single display window." Therefore, although the Examiner has asserted some motivation to combine the references, this motivation would not lead one having ordinary skill in the art to the claimed invention.

Finally, Appellants note that Appellants' response is predicated on the belief that the Examiner is employing rationale (G) from the Examination Guidelines. Although rationales (A)-(F) are also available to the Examiner, the Examiner has neither explicitly asserted that the Examiner is employing these rationales nor articulated all of the required findings of facts for employing these alternative rationales, as described within the Examination Guidelines.

For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 16, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320